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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
08/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/644,955	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5-13* is/are pending in the application.

4a) Of the above claim(s) *11-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 10, 2007 has been entered.

The Examiner acknowledges that claims 1, 2, 5, 9, & 10 are currently amended, claims 3 & 4 are canceled, and no new claims have been added. Therefore, claims 1-10 are currently pending on the merits. Claims 11-13 remain withdrawn from consideration due to an "election by original presentation" as discussed in the office action mailed March 13, 2007 and as discussed below.

Election/Restrictions

In the Final Office Action dated March 13, 2007, the Examiner had submitted a restriction of inventions with respect to newly submitted claims 11-13. The restriction was traversed and it was requested that a full explanation be placed on record, thus, the following is the Examiner's submission as reasons for restriction.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, & 5-10, drawn to a gaming machine having a plurality of components including a variable device, a lottery device, a stop control device, a stop control selection device, a shielding device, and a shielding control device, classified in class 463, subclass 20.

II. Claims 11-13, drawn to a method of controlling a display associated with the play of a game, where the game includes multiple groups of symbols, classified in class 463, subclass 31.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the Examiner submits that the process of use, or Invention II, is a method of controlling the display of symbols, where the particularly claimed method is useable on a variety of products or devices other then the particular device of Invention I. For example, it appears quite possible to implement the invention of II on a device other then that of Invention I, such a cellular telephone, where the cellular telephone is capable of displaying a game, where this particular method of controlling images may be carried out, since the method makes no indication that two separate particular display devices (i.e. the variable and shielding devices of Invention I) are required. Thus, the Examiner submits on a cellular telephone screen multiple groups of symbols may be varied by the cellular telephone's liquid crystal display, while simultaneously the liquid crystal display may also be usable to shielding the display of just two of the groups of symbols while revealing or unshielding the third group. For at least this reason, Invention II, the process, is considered capable of being practiced on another materially different product. Additionally, Invention I, the product does not necessarily require the specific process of use, as it appears the shielding device is capable of being used via various other methods of displaying symbols.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a

separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The restriction was considered an "election by original presentation" in the Final Office Action mailed March 13, 2007, thus, at the time, the applicant had already received an action on the merits for the originally presented invention, thus, that invention (Invention I, claims 1, 2, & 5-10) has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) & MPEP 821.03.

Claim Objections

Claims 1 & 5 objected to because of the following informalities: Claims 1 & 5 each appears to include a plurality of minor grammatical and/or typographical errors. In claim 1, it appears that the word "a" should be added before each of the devices to be grammatically proper (i.e. "a variable display device" instead of "variable display device"). Claim 1 at limitation (b) should recite "the CPU" rather then "a CPU". Claim 1, at limitation (e) should recite "the variable display device" rather then "the variable displaying device" to avoid any 35 U.S.C. 112 lack of antecedent basis rejections (it appears the applicant

amended "display" to "displaying" in the last amendment; it is unclear to the examiner as to the reason for that change). Claim 5, at limitation (d) should recite "the variable display device" rather then "the variable display devices" as only "a variable display device" is recited earlier portion of limitation (d). Additionally, it would appear that "a" should be added before "variable display device" in limitation (d). There may be other minor grammatical and/or typographical errors missed by the Examiner, thus, it is requested that the Applicant read through the claims and amend any apparent grammatical and/or typographical errors. Appropriate correction is required.

Claim 10 is objected to because of the following informalities: Claim 10 recites "the reel" where the amendments to it's parent claim have added that the variable device has a plurality of rotating reels, thus, it is unclear as to which "the reel" is refereeing to and it is unclear as to what the Applicant intends to claim with claim 10, as it appears the claim's limitations are covered by the parent claim, except for explicitly having the symbols on the periphery of the reels. Clarification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, & 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Muir et al. (U.S. Patent Application Publication No. 2005/0192090, U.S. PCT filed October 29, 2002).

Claims 1 & 2: Muir et al. disclose the same invention including a gaming machine comprising:

a) a variable display device having a plurality of rotatable reels for varyingly displaying a plurality of symbols under the control of a central processing unit or CPU (figure 2 or 8[reels 18] and paragraphs 0009 & 0045);

b) a lottery device for executing a lottery for a prize pattern under control of the CPU (paragraph 0014 discloses the reels are used to play a spinning reel game as depicted in at least figures 3-4, where the "device" to execute the lottery is considered the game controller as depicted in figure 2);

c) a stop control device for controlling and stopping the variable display device under control of the CPU (figure 2[controller 44]);

d) a stop control selection device for selecting a control type of the stop control device based on the result of the lottery under control of the CPU (figure 2 [processor 42 & controller 44] and where it is known for the controller/processor of a game machine to stop reels based on the random outcome of the lottery, such that the random outcome is reverse mapped to the symbols, so the symbols shown at rest condition correspond to the randomly determined game outcome);

e) a shielding device (i.e. an electronic shutter) for shielding a view of the variable display device under control of the CPU, the shielding device being disposed in front of the variable display device (figure 8[electronic shutter 76] & paragraphs 0061-0063);

f) a shielding control device for controlling the shielding device under control of the CPU (paragraph 0063 discusses that upon application of appropriate energy levels, the zones 78 of the shutter 76 are rendered opaque or transparent and where the shielding control device is considered the processor 42; additionally the remainder of limitation (e) is considered functional language, thus, the Applicant is directed to MPEP 2114 that discusses functional language within an apparatus claim, where it has been held that an apparatus claim must be structurally distinguishable

from the prior art. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 [Board of Patent Appeals & Interferences, 1987]); and

g) a special game controller for causing a special gaming state that is advantageous to the player under a predetermined condition, wherein the shielding control device controls the shielding device during the special game state (paragraphs 0051 & 0052 discloses that a special game feature, such as a bonus or secondary game, is possible where the shielding is applicable during the special game state as well, and where it is inherent that the special game state or bonus round is more advantageous the player because of the opportunity to obtain additional or higher awards then in a base or primary game, and where the control circuit 40 having the processor 42 and controller 44 of figure 2 are considered to be the special game controller, as the game controller operates the gaming machine's features).

Claims 5 & 6: Muir et al. disclose the same invention including a gaming machine having a display device, comprising:

a) a substantially transparent panel disposed on the display device (figure 8[touch screen panel 70], where the touch screen is considered a transparent panel disposed on the display device);

b) an image display device for displaying an image under control of a central processing unit or CPU, the image display device being provided behind the panel, so as to show the image visibly through the panel (figure 8[LCD monitor 68]);

c) an electronic shutter being disposed behind the image display device (figure 8[shutter 76]; additionally, the "wherein clause" at the end of the claim appears to be functional language as to disclose how the shutter is intended to be used, however, the Applicant is directed to MPEP

2114 that discusses functional language within an apparatus claim, where it has been held that an apparatus claim must be structurally distinguishable from the prior art. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all of the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 [Board of Patent Appeals & Interferences, 1987]);

d) a variable display device having a plurality of rotating reels for displaying symbols varyingly under control of the CPU, the variable display devices being provided behind the shutter such that at least a portion of the symbols is shielded by the shutter (figure 8[game playing arrangement or reels 18] and paragraphs 0061-0063); and

e) a special game controller for causing a special gaming state that is advantageous to the player under a predetermined condition, wherein the shutter is controlled during the special game state (paragraphs 0051 & 0052 discloses that a special game feature, such as a bonus or secondary game, is possible where the shielding via the shutter is applicable during the special game state, and where it is inherent that the special game state or bonus round is more advantageous the player because of the opportunity to obtain additional or higher awards then in a base or primary game).

Claim 7: Muir et al. disclose the shutter is substantially flat and comprises a substantially transparent portion such that another portion of the symbol behind the shutter is not shielded by the shutter (figures 6-8 & paragraph 0051).

Claim 8: Muir et al. disclose the image display device is an LCD monitor (figure 8).

Claim 9: Muir et al. disclose illuminating elements with the display device structure (figure 8[illuminating elements 86]).

Claim 10: Muir et al. disclose the variable display device comprises reels (figure 8[reels 18]) and that the reels having a plurality of symbols on the outer peripheral surface (figures 3 & 4 and paragraph 0009).

Response to Arguments

As an initial matter, the outstanding double patenting rejection is hereby withdrawn due to the conflicting claims of the co-pending application being canceled within prosecution of that application. Thus, it appears, no double patenting issues remain.

Applicant's arguments with respect to claims 1, 2, & 5-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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M.B.S.